PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Inventors: Johannes Aebi, et al. Group: 1626

Serial No. 10/014,959, filed December 11, 2001 Examiner: A.D. Small

For: DIHYDROINDOLE AND TETRAHYDROQUINOLINE DERIVATIVES

COMMUNICATION

Nutley, New Jersey 07110
Date: April 22, 2003

Commissioner for Patents
Washington, D.C. 20231

Sir:

This Communication is filed in response to the February 24, 2003 Office Action issued in connection with the above-identified patent application. A response to this Office Action was originally due March 24, 2003 and a one-month extension of time is being filed concurrently. Accordingly, a response is now due April 24, 2003.

In the Office Action restriction was required under 35 U.S.C. § 121. Specifically, there are allegedly three independent and distinct groups of inventions. Group I includes claims 1-60 and 62, drawn to compounds. Group II includes claim 63, drawn to a method of treatment and/or prophylaxis. Group III includes claim 61, drawn to a process.

In response to this restriction requirement, applicants elect, with traverse, to prosecute at this time the invention of Group I, claims 1-60 and 62. Applicants traverse this restriction since it would not be a serious burden on the Examiner to search all of the claims at this time.

Applicants were also required to elect a species for examination purposes. To this end, applicants elect the species 5-{5-[ethyl-(2-hydroxy-ethyl)-amino]-pent-1ynyl}-6-fluoro-2,3-dihydro-indole-1-carboxylic acid 4-chloro-phenyl ester, as described in Example 16.12 on page 96 of the specification.

In the Office Action, there is a statement that "a generic concept, inclusive of the elected species, will be identified by the Examiner for examination." There is no basis in law for such a statement. However, even if such a construct were to be used for the convenience of the Patent Office for searching purposes, applicants are entitled to the examination on the merits of all claims not withdrawn from consideration in their entirety.

It is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978) at pages 331-332,

"§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text).

Applicants have the right to claim their invention as they deem appropriate, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold*, 179 USPQ 620, 622 (CCPA 1973).

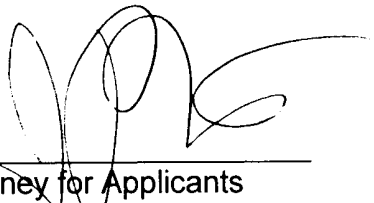
In view of the above, even if the Patent Office were to make the restriction requirement final and applicants were not to petition the restriction or were to have such a petition denied, the Patent Office would be required to examine on the merits the entirety of claims 1-60 and 62.

In summary, applicants request reconsideration and withdrawal of the restriction requirement. Even if the restriction requirement were to be upheld, applicants are entitled under the law to a full examination on the merits of the entirety of claims 1-60 and 62 pending in the application.

If a telephone conference would be of assistance in furthering prosecution, applicants request that the undersigned attorney be contacted at the number below.

No fee, other than the fee for a one-month extension of time, is required in connection with the filing of this Communication. If any fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



Attorney for Applicants
John P. Parise
(Reg. No. 34,403)
340 Kingsland Street
Nutley, New Jersey 07110
Telephone: (973) 235-6326
Telefax: (973) 235-2363